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Wendy A. Frick

Customer Number

24024



Signed:

*Wendy A. Frick*

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Kaumaya, et al.

Serial No.: 09/990,574

Filed: November 21, 2001

For: **AGENTS FOR BLOCKING T CELL  
MEDIATED IMMUNE REACTIONS**

) Examiner: Ouspenski, Ilia I  
)  
)

) Art Unit: 1644  
)  
)

) Attorney Docket No.: 18525/04028  
)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT**

Dear Sir:

In response to the Restriction Requirement mailed August 12, 2004, Applicants hereby elect Group I, Claims 1-16, drawn to a CD28 peptide mimetic for blocking T cell mediated immune reaction, wherein the peptide mimetic comprises the sequence of SEQ ID NO:5. The election is with traverse.

The Office carefully makes the case that the claims of Groups I, and II are **distinct**:

Groups I and II are related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product ..... In the instant case treating of subjects or blocking CD4+ cells can be practiced with anti-CD28 antibodies, in addition to the CD28 mimetics recited.

(Office Action, pages 2-3.)

Applicant submits that restriction is not proper in this instance. M.P.E.P. § 803 states the requirement for a **proper** restriction.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and **(B) There must be a serious burden on the examiner if restriction is required.**

(M.P.E.P. § 803, citations omitted, emphasis added.) Thus, there are **two** requirements for restriction: distinctness **and** a **serious** burden. Both are required; distinctness without a serious burden is not sufficient to justify restriction. Indeed, section 803 explicitly states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

Applicant respectfully submits that restriction is not proper in this case. While the claims of Groups I and II may satisfy the Office’s requirements for distinctness, their consideration would not result in a **serious** burden on the Office. Thus, Applicant respectfully requests that the Office consider Groups I and II (i.e., claims 1-32) together.

Respectfully submitted,

Date:

October 12, 2004

By:

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